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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/038,572

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Scott A. McKenney

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NEAL, GERBER, & EISENBERG

SUITE 2200

2 NORTH LASALLE STREET

CHICAGO, IL 60602

EXAMINER

ARAQUE JR, GERARDO

ART UNIT

PAPER NUMBER

3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/18/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/038,572

Applicant(s)

MCKENNEY ET AL.

Examiner

Gerardo Araque Jr.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-22, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1 – 15** are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Many features, the details of which described below, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent (MPEP 2164 [R-2] The Enablement Requirement).

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? (2164.01 Test of Enablement)

3. In regards to **claim 1 part d**, the applicant does not disclose how to properly select the appropriate data for a given emergency situation, and, as a result, would burden one skilled in the art with undue experimentation of selecting the same

necessary data on a repeatable basis for the same given emergency situation. Any further issues regarding 35 USC 112, first paragraph, is discussed below.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1 – 15** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. In regards to **claim 1**, applicant has included a “step f”, however, the examiner does not see “steps a – e.” The examiner is unsure of why a “step f” is present.

7. The term “**and/or**” in **claim 1** is a relative term which renders the claim indefinite. The term “and/or” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The examiner is unsure as to what should be or what shouldn’t be included in the claim.

#### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 1 – 15** are rejected under 35 U.S.C. 101 because the invention fails to produce a “concrete” result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re

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Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, because the invention cannot operate as intended without undue experimentation. See *infra*.

In regards to **claim 1 part d**, the action of selecting data is subjective and will vary depending on the person doing the actual selection. What one person may deem as crucial information to an emergency situation may necessarily not be the same in someone else’s point of view. As a result, the action of selecting the data necessary to assess the given emergency situation is not repeatable and will produce different results. Any further issues regarding 35 USC 101 is discussed below.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. **Claims 1 – 7, 9 – 11, 13 – 22, and 24 – 25** are rejected under 35 U.S.C. 102(a) as being anticipated by Quick (Patent Application Publication Number US 2001/0056435A).

12. In regards to **claim 1**, as best understood by the examiner, Quick discloses a system, method and apparatus for the collection, management, and dissemination of information needed by emergency response personnel (Page 2 Column 1 Paragraph 31 Lines 1 – 6). The system contains, “reports called “pre-plans” or “pre-fire surveys” often contain site maps or floor plans and other data that emergency response personnel need to know when responding to an accident in a facility (Page 1 Column 2 Paragraph 18, Figures 3 – 6).” Quick also discloses that the user inputs information in order to allow personnel to fully understand the nature of the chemicals that are involved in the incident and selecting the appropriate reports in order to respond to the situation properly (Page 1 Column 23 Paragraph 26; Page 4 Column 1 Paragraph 65). Moreover, Quick discloses, “...information contained in the secure database **12** is also particularly valuable when combined with post-incident information. Either during or following an incident, as previously described, emergency response personnel may add information regarding the incident to the secure database **12** (Page 6 Column 1 Paragraph 83).” Further still, Quick also discloses collecting resource data, which can be used to respond to an emergency situation as well as a checklist and list of resources needed for the emergency situation (Page 1 ¶ 2, Pg. 2 ¶ 27, Pg. 3 ¶ 49, Pg. 4 ¶ 67, Figure 5 & 9).

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13. In regard to **claims 2 and 17**, Quick discloses that the system, method, and apparatus is build around a secure database, in which the information can only be accessed by authorized personnel (Page 2 Column 2 Paragraph 32) and that information can be added to the database during or following an incident by keeping track of the various activities (Page 4 Column 1 Paragraph 68, Page 6 Column 1 Paragraph 83). It is inherent that a computer must be used in order to access this database (Page 5 Column 2 Paragraph 78).

14. In regard to **claims 3 and 18**, as best understood by the examiner, Quick discloses that the secure database contains several categories of information for determining the best solution to approaching and preparing for an emergency (Page 2 Column 2 Paragraphs 42 – 47).

15. In regards to **claim 4**, Quick discloses that the wireless communication devices connected to the system allows for the user to look up the current weather (Page 5 Column 2 Paragraph 79, Figures 7A – 7C).

16. In regards to **claim 5**, Quick discloses that the user is able to select the necessary data from the secure database depending on the nature of the situation (Page 4 Column 1 Paragraph 65).

17. In regards to **claim 6**, as best understood by the examiner, the secure database that Quick discloses is inherently accessed by a computer, which contains a CPU. Moreover, the secure database disclosed by Quick allows the user to access floor plans to allow them to locate necessary equipment, such as hydrant and stand-pipe locations

if water is necessary, and other locations that may be pertinent to the situation at hand (Page 1 Column 2 Paragraphs 19 – 24).

18. In regards to **claim 7**, as best understood by the examiner, Quick discloses that reports, called “pre-plans” or “pre-fire surveys”, are available for emergency response teams to use. Using these reports, the emergency response team can determine the best action to take for the given situation (Page 1 Column 2 Paragraphs 18 – 25).

Moreover, wireless communication is available for the emergency response team to further understand the situation en route to the location (Page 5 Column 2 Paragraph 78, Figures 7A – 7B).

19. In regards to **claim 9**, Quick also discloses that the user inputs information in order to allow personnel to fully understand the nature of the chemicals that are involved in the incident and selecting the appropriate reports in order to respond to the situation properly (Page 1 Column 23 Paragraph 26; Page 4 Column 1 Paragraph 65).

Moreover, the secure database disclosed by Quick allows the user to access floor plans to allow them to locate necessary equipment, such as hydrant and stand-pipe locations if water is necessary, and other locations that may be pertinent to the situation at hand (Page 1 Column 2 Paragraphs 19 – 24).

20. In regards to **claim 10**, Quick discloses that the secure database is located at a firehouse with a stationary computer in order to make an initial preparation for the situation. When the emergency response team is ready to be dispatched they have wireless communication devices in order to gather additional information on the situation (Page 5 Column 2 Paragraph 78, Figures 7A – 7B).



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21. In regards to **claim 11**, Quick discloses that the secure database is broken into different categories in order to access the necessary information efficiently and quickly and that floor plans and other data needed by the emergency response team is available (Page 1 Column 2 Paragraph 18, Page 2 Column 2 Paragraphs 43 – 47).

22. In regards to **claim 12**, applicant has **canceled** the claim.

23. In regard to **claims 13 – 15**, as best understood by the examiner, Quick discloses that the information can be distributed either before or after the incident and the additional information can be used to update any outdated information or write post-incident reports (Page 2 Column 2 Paragraph 31, Page 3 Column 1 Paragraph 53).

Moreover, with the use of the wireless communication additional information can be relayed from the incident site to the user in front of the computer connected to the secure database and track the activities being inputted to the secure database (Page 4 Column 1 Paragraph 68, Page 5 Column 2 Paragraph 78 & 79, Figures 7A – 7B).

24. In regards to **claim 16**, Quick discloses a system, method, and apparatus for the collection, management, and dissemination of information needed by emergency response personnel for an emergency situation (Page 2 Column 1 Paragraph 31).

When a call is made related to an emergency situation the emergency response personnel gathers as much information as possible in order to properly prepare for the situation and input any necessary data into the secure database for the emergency response personnel to review and understand, such as address details and chemical identification details (Page 4 Column 1 Paragraph 65, Page 5 Column 2 Paragraph 78).

Moreover, the secure database makes available to the emergency response personnel

various reports for handling response to an incident (Page 4 Column 1 Paragraph 65). Furthermore, with the use of the wireless communication additional information can be relayed from the incident site to the user in front of the computer connected to the secure database and track the activities being inputted to the secure database (Page 4 Column 1 Paragraph 68, Page 5 Column 2 Paragraph 78 & 79, Figures 7A – 7B). Further still, Quick also discloses collecting resource data, which can be used to respond to an emergency situation as well as a checklist and list of resources needed for the emergency situation (Page 1 ¶ 2, Pg. 2 ¶ 27, Pg. 3 ¶ 49, Pg. 4 ¶ 67, Figure 5 & 9).

25. In regard to **claims 19 – 20**, Quick discloses that “pre-plans”, “pre-fire surveys”, or risk management plans are offered in order for emergency response personnel to determine the safer and best course of action for the situation at hand (Page 1 Column 2 Paragraphs 18 – 25). Moreover, Quick also discloses that the addition of a software to extract necessary information stored in the secure database can also be enabled (Page 3 Column 1 Paragraph 52).

26. In regard to **claims 21 – 22 and 24 – 25**, Quick discloses that the information can be distributed either before or after the incident and the additional information can be used to update any outdated information or write post-incident reports (Page 2 Column 2 Paragraph 31, Page 3 Column 1 Paragraph 53). This would inherently require necessary information, such as the date and time, to be included in the reports and as well as when the most recent information was last updated. Moreover, the information that is stored in the secure database will offer emergency response

personnel to determine the safer and best course of action for the situation at hand and what equipment is necessary in order to deal with the incident properly (Page 1 Column 2 Paragraphs 18 – 25, Page 4 Column 1 Paragraph 65, Figure 3). Furthermore, with the use of the wireless communication additional information can be relayed from the incident site to the user in front of the computer connected to the secure database and track the activities being inputted to the secure database (Page 4 Column 1 Paragraph 68, Page 5 Column 2 Paragraph 78 & 79, Figures 7A – 7B).

27. In regards to **claim 23**, applicant has **canceled** the claim.

***Claim Rejections - 35 USC § 103***

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Quick (Patent Application Publication Number US 2001/0056435A) in view of Associated Realty Property Management

(<http://web.archive.org/web/20000817071152/http://www.arpm.com/>).

30. In regards to **claim 8**, as best understood by the examiner, Quick is discussed above, but fails to teach implementing a virtual walkthrough of the location. However, it is well known in the art to offer virtual walkthroughs in order to allow someone to fully understand the actual layout of a location. Moreover, realty offices, such as Associated Realty Property Management (ARPM), offer virtual walkthroughs to allow a tenant to

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fully appreciate the layout of an apartment that they fail to see on simple floor plans (<http://web.archive.org/web/20001208075700/www.arpm.com/ipix.asp>). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of ARPM to include a virtual walkthrough of a building in order to allow an emergency response team to fully understand the current layout of a floor and better prepare for the situation.

### ***Response to Arguments***

31. Applicant's arguments filed 10/6/2006 have been fully considered but they are not persuasive.

32. Objections made towards the drawings are withdrawn.

33. Objections made towards the Oath/Declaration are withdrawn.

34. Objections made towards the Abstract are withdrawn.

35. Rejections made under 35 USC 112, first paragraph, towards claims 3 and 18 are withdrawn.

36. Rejections made under 35 USC 112, second paragraph, towards claims 1 and 23 are withdrawn.

### **Rejections made under 35 USC 101 & 112, first paragraph**

37. The examiner has maintained the rejection made towards claim 1 part d because one skilled in the art would not know how to carry out the invention in a way that would produce repeatable/predictable results. As the examiner has discussed above, the invention fails to produce a "concrete" result, thus failing the "Concrete Result" test. The applicant has clearly stated in the arguments (Page 10 & 12) that the method of

“...selecting data within said hierarchy and said spatial diagrams necessary to assess said emergency situation...” is being done by a user/individual, which would result in subjective selection. Applicant has stated that by providing information in regards to an emergency situation would be sufficient enough to carry out the invention. However, the fact of just providing various types of information would not result in the same outcome for a given emergency situation. Specifically, depending on the level of experience of the personnel assessing the emergency situation, various outcomes would occur. For example, an individual who has a high level of experience may find that a specific procedure should be done first while another individual who has a very low level of experience may find that the same procedure should be done later because a specific handbook had said so.

Further still, applicant has also amended the claim to include a method of preparing a checklist, but has failed to disclose it in a way that is enabled and “concrete.” Specifically, what is the information on the checklist based on?

Furthermore, the examiner does not understand why a selecting step is disclosed when the selection has already be predetermined. Specifically, the applicant discloses that only facility data is stored in a hierarchy and spatial diagram. Since only one piece of data is stored there is no spatial diagram and, further still, there is no need to select any data since only one piece of data has been stored.

Moreover, applicant states on Page 12 “Even if the previous step does not provide a concrete and tangible result, the providing an interface step certainly does

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provide a concrete and tangible result, as required by section 101." However, the examiner finds to evidence of this in the MPEP section 101.

b) "TANGIBLE RESULT"

**The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing.** However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application."). "[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection." Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract."

c) "CONCRETE RESULT"

Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. **In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again.** In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). **The opposite of "concrete" is unrepeatable or unpredictable.** Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. 112, paragraph 1, where the invention cannot operate as intended without undue experimentation. See infra.

In conclusion, the examiner will maintain the rejections made under 35 USC 112, first paragraph, and 35 USC 101 for claim 1.

**Rejections made under 35 USC 102 and 103(a)**

38. Rejections made towards the amended sections of the claims are discussed above.

***Conclusion***

39. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GA  
12/5/06



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